

REMARKS

With this Response, claims 22, 24, 27, 29, 31, 34, and 36 are amended. Applicants respectfully request that claims 26, 33, and 38 be canceled without prejudice. Applicants present herein new claims 43-51. Therefore, claims 22-25, 27-32, 34-37, and 39-51 are pending.

CLAIM REJECTIONS - 35 U.S.C. § 102

Claims 22-24, 29-31, and 36-38 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,026,376 issued to Kenney et al. (*Kenney*). Claim 38 is canceled herein, rendering the rejection of claim 38 moot. Applicants respectfully submit that the remaining claims are not anticipated by the cited reference for at least the following reasons.

Claims 22-24 and 29-31

Claim 22 as amended herein recites, in part:

submitting electronically a new order for a **previously ordered medication** in response to the medication being selected from the list via the personal electronic device, wherein the new order is forwarded to a **prescription distribution center** if the new order is for prescription medication, and to an **over the counter (OTC) distribution center** if the new order is for OTC medication.

Claim 29 includes limitations similarly directed to submitting a new order for a previously ordered prescription or OTC medication.

Kenney fails to disclose or suggest submitting a new order for a previously ordered prescription or OTC medication, as recited in the claims. Therefore, *Kenney* fails to disclose or suggest at least this element of the claims, and so fails provide support for *prima facie* anticipation under MPEP § 2131 for independent claims 22 and 29. Because dependent claims necessarily include every limitation of the claims from which they depend, Applicants respectfully submit that the reference fails to anticipate claims 23-24 and claims 30-31, which depend from claims 22 and 29, respectively.

Claims 36-37

Claim 36 as amended herein recites, in part:

means for analyzing the frequency of orders of the products to determine a period of time for a subsequent order; and
means for **producing an automatic reminder** for the user to **indicate that the period of time has expired.**

The Office Action at page 2 points to the discussion in *Kenney* at col. 6, lines 19 to 33 regarding tracking the frequency of product ordering and displaying a frequency of purchase computation to the user. Whether or not *Kenney* discloses making a frequency computation, *Kenney* fails to disclose or suggest producing an automatic reminder for a user to indicate a period of time for a subsequent order has expired, as recite in claim 36. Because this claim includes at least one element not disclosed by *Kenney*, Applicants respectfully submit that *Kenney* fails to provide support for prima facie anticipation under MPEP § 2131 for independent claim 36. Because dependent claims necessarily include every limitation of the claims from which they depend, Applicants respectfully submit that the reference fails to anticipate claims 37-38, which depend from claim 36.

CLAIM REJECTIONS - 35 U.S.C. § 103

Claims 25, 32, and 39

Claims 25, 32, and 39 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Kenney* and the Official Notice taken that saving a previous shipping address is known in the art. Whether or not it is known in the art to save a previous shipping address, Applicants respectfully submit that the Official Notice fails to cure the deficiencies of *Kenney* noted above with respect to the independent claims from which these claims depend. Because *Kenney* is shown above to fail to anticipate claims 22, 29, and 36, from which claims 25, 32, and 39 depend, respectively, Applicants submit the combination of the cited reference and the Official Notice fails to render

obvious the invention as recited in these claims for at least the reasons set forth above with respect to the independent claims.

Claims 26-27, 33-34, and 40-41

Claims 26-27, 33-34, and 40-41 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Kenney* in view of www.drugstore.com. Applicants submit that this is an improper rejection, to which Applicants are unable to respond. The use of electronic publications in rejection of claims is set forth in MPEP § 2128, which states: "Prior art disclosures on the Internet or on an online database are considered to be publicly available as of the date the item was publicly posted. **If the publication does not include a publication date (or retrieval date), it cannot be relied upon as prior art** under 35 U.S.C. 102(a) or (b)." Emphasis added. Applicants note that if a publication cannot be relied upon as prior art under 35 U.S.C. §§ 102(a) or (b), it is similarly disqualified as prior art under 35 U.S.C. §103(a). The Office Action fails to establish that the electronic publication www.drugstore.com qualifies as prior art. Applicants note that the Internet posting does not include a publication date, and therefore submit that "**it cannot be relied upon as prior art.**"

Furthermore, even assuming that the website qualified as prior art, which Applicants maintain is improper under MPEP § 2128, Applicants respectfully point out that the Office Action fails to provide with specificity what in the website is purported to disclose the invention as claimed. 37 CFR § 1.104(c)(2) states: "In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the **particular part relied on must be designated** as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified."

determinable number of pages of information. Applicants therefore respectfully request that assuming the website can be relied upon as prior art, which Applicants maintain is improper, the particular parts of the cited reference (the website) purported to disclose the individual elements of the claim be designated in order for Applicants to be able to provide a response to the rejections.

Claims 28, 35, and 42

Claims 28, 35, and 42 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Kenney* in view of U.S. Patent No. 5,991,601 issued to Anderson (*Anderson*). Applicants respectfully submit that the cited references fail to render obvious the invention for at least the following reasons.

Applicants refer to the discussion above regarding the deficiencies of *Kenney*. The Office Action at page 4 cites *Anderson* as disclosing suggesting related products to a consumer. Whether or not *Anderson* discloses suggesting related products to a consumer, *Anderson* fails to cure the deficiencies of *Kenney* set forth above with respect to the independent claims from which these claims depend. Because dependent claims necessarily include the limitations of the independent claims from which they depend, Applicants respectfully submit that the cited references, either alone or in combination, fail to disclose or suggest every element of the claims. Therefore, the references fail to render obvious the invention as claimed.

Conclusion

For at least the foregoing reasons, Applicants submit that the rejections have been overcome. Therefore, Applicants respectfully submit that all pending claims are in condition for allowance and such action is earnestly solicited. The Examiner is respectfully requested to

Please charge any shortages and credit any overcharges to our Deposit Account number

02-2666.

Respectfully submitted,
BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN, LLP

Date:

8/6/04

Vincent H. Anderson
Vincent H. Anderson
Reg. No. 54,962

12400 Wilshire Blvd., 7th Floor
Los Angeles, CA 90025-1026
Telephone: (503) 684-6200

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail with sufficient postage in an envelope addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313 on:

6 AUGUST 2004

Date of Deposit

DEBORAH L. HIGGINS
Name of Person Mailing Correspondence

DOLLY
Signature

8-6-04
Date